

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. **0837RF-H543-US**

In Re Application of:

DANIEL J. SWEIGARD

Serial No.: **10/509,928**

Filed: **1 OCTOBER 2004**

For: **CLIP FOR FIRE DETECTOR
WIRE**

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Examiner: **KIMBERLY T. WOOD**

Confirmation No.: **4313**

Art Unit: **3632**

REPLY BRIEF

MAIL STOP: APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Examiner's Answer mailed 29 September 2008, the Examiner raised certain new points of argument. Accordingly, this Reply Brief is being filed pursuant to 37 C.F.R. § 41.41(a) in response to the Examiner's Answer, for which the two-month date for response is 1 December 2008, as 29 November 2008 fell on a Saturday and 30 November 2008 fell on a Sunday.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)
Date of Transmission: 1 December 2008
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.
By: <u>/darencdavis#38425/</u> Daren C. Davis

Status of Claims (37 C.F.R. § 41.37(c)(1)(iii)):

The present Application, which is an application filed on 1 October 2004 under 35 USC § 371 from an International Patent Application filed on 1 April 2003 under the Patent Cooperation Treaty claiming the benefit of U.S. Provisional Patent Application Serial No. 60/369,753, filed on 3 April 2002, was originally filed with four claims (*i.e.*, claims 1-4).

In Appellant's amendment dated 3 January 2006 in response to the Office Action of 4 October 2005, new claims 5-20 were added. No claims have been canceled. Thus, claims 1-20 are presently under consideration in the appealed Application.

In a Final Office Action dated 5 February 2008 ("Final Office Action"), the Office Action Summary indicates that claims 1-20 are finally rejected and that no claims are allowed or objected to.

The status of the claims is, therefore, believed to be as follows:

Allowed claims:	None
Claims objected to:	None
Claims rejected:	1-20.

Appellant hereby appeals the Examiner's final rejection of the foregoing claims (*i.e.*, claims 1-20), which presently stand rejected over the cited references.

Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. § 41.37(c)(1)(vi)):

Issue No. 1. Claims 1-4, 6-12, and 14 stand rejected under 35 USC § 103(a), as being unpatentable over Appellant's Admitted Prior Art ("AAPA") in view of U.S. Patent 5,248,119 to Imura ("Imura"). Thus, the issue is whether the teachings of AAPA and Imura disclose or suggest all of the limitations of the claims as necessary for establishing a *prima facie* case of obviousness.

Issue No. 2. Claims 5, 13, and 15-20 stand rejected under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura and U.S. Patent 3,710,674 to Tabor ("Tabor"). Thus, the issue is whether the teachings of AAPA, Imura, and Tabor disclose or suggest all of the limitations of the claims as necessary for establishing a *prima facie* case of obviousness.

Argument (37 C.F.R. § 41.37(c)(1)(vii)):

Issue No. 1 – Rejection Under 35 USC §103(a) Over AAPA in view of Imura

In the Examiner's Answer, the Office continues to allege that Imura discloses an anti-friction insert member.¹ The Office acknowledges on the record that Imura's member 4 is "used to resiliently grip a cylindrical member."² Appellant respectfully asserts that one of ordinary skill in the art would not have understood Imura's member 4 as being "anti-friction" in nature if member 4 is "used to resiliently grip a cylindrical member."

In the Examiner's Answer, the Office relies upon Imura's teaching that "'(4) is a resinous or rubber elastic member,'" and alleges that a "'a resinous' member would include 'plastic material' which provides anti-friction characteristics inherently." The Office relies upon Tabor to disclose "'a sleeve 44...constructed of a suitable anti-friction plastic material'" to prove that "plastic materials" provide anti-friction characteristics inherently.³ The Office further alleges that, since Imura discloses "a resinous or rubber elastic member," one of ordinary skill in the art would have been prompted to alter the material of Imura to consist of polytetrafluoroethylene because the Office contends polytetrafluoroethylene is "a 'resinous' material therefore meeting the requirement of Imura." The Office contends that this change in material is within the general skill of a worker, as is merely a change based upon the material's suitability for the intended use.⁴

Firstly, Appellant respectfully submits that one of ordinary skill in the art would have interpreted the phrase "resinous or rubber elastic member" as being a resinous elastic member or a rubber elastic member. In other words, Imura's member 4 is an elastic member, which can be either resinous or rubber in nature. This position is evidenced by the teaching in Imura that "[a]n elastic member composed of a collar, a split-bush, a band or a tube is fitted or bonded to inner peripheral surfaces of the seizing walls or an outer peripheral surface of the pipe."⁵ The "elastic member" recited in Imura is Imura's member

¹ Examiner's Answer, p. 4, ll. 6-7.

² Final Office Action, Detailed Action, p. 6, l. 2.

³ Examiner's Answer, p. 6, ll. 2-17.

⁴ Examiner's Answer, p. 4, l. 23, through p. 5, l. 9, citing *In re Leshin*, 125 USPQ 416.

⁵ Imura, col. 2, ll. 5-8.

4. Thus, Appellant respectfully asserts that one of ordinary skill in the art would not have understood the phrase “resinous or rubber elastic member” as merely being a resinous member, as alleged by the Office.

Secondly, Appellant respectfully submits that one of ordinary skill in the art would not have appreciated that plastic materials, as a genus, inherently provide anti-friction characteristics. This position is evidenced by the teaching in Tabor that “the relaxed tapered sleeve 44 is constructed of a suitable **anti-friction plastic material**, such as the materials known as Teflon or Nylon”⁶ (emphasis added). Appellant respectfully asserts that one of ordinary skill in the art would have understood, based at least upon Tabor’s disclosure, that some plastic materials have anti-friction properties, while others do not. Otherwise, Tabor’s use of “anti-friction” along with “plastic material” would have been redundant and, thus, unneeded. Appellant respectfully traverses the Office’s contention that plastic materials, in general, inherently provide anti-friction characteristics, especially in light of Tabor, which is cited by the Office to teach that such characteristics are inherent in plastic materials.

Thirdly, Appellant respectfully asserts that one of ordinary skill in the art would have understood that anti-friction plastic materials, such as the materials disclosed in Tabor, would not have been suitable for use in the Imura device. Imura explicitly teaches that member 4 is “an elastic member,”⁷ which frictionally grips pipe P, as discussed in greater detail below. Tabor, however, teaches that the material for sleeve 44 is “sufficiently rigid and resilient.”⁸ One of ordinary skill in the art would have understood that any anti-friction material, especially those that are “rigid and resilient,” would not be appropriate for use in the Imura device. Accordingly, Appellant respectfully asserts that one of ordinary skill in the art would have been led away from using the material of Tabor in Imura’s device. Where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination.⁹ It is

⁶ Taboor, col. 4, ll. 38-40.

⁷ Imura, col. 2, ll. 5-8.

⁸ Tabor, col. 4, l. 42.

⁹ *In re Gordon*, 221 USPQ (BNA) 1125, 1127 (Fed. Cir. 1984).

by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.¹⁰

In the Examiner's Answer, the Office traverses Appellant's contention that Imura's member 4 frictionally grips pipe P.¹¹ The Office, however, admits on the record that "Imura provides a insert (4) used to resiliently grip a cylindrical member."¹² Accordingly, Appellant respectfully continues to assert that a person having ordinary skill in the art at the time of the invention would have appreciated that Imura's member 4 frictionally grips the pipe P, as discussed in Appellant's Appeal Brief.

In the Examiner's Answer, the Office alleges that, in Imura, "the insert flanges structure and spacing would be used to meet the applicant's goal of preventing positional deviations in the lengthwise direction," because Imura is drawn to the particular problem of 'effectively preventing positional deviations in the lengthwise and peripheral direction on the side of the pipe.'¹³ Irrespective of the problem to which Imura is drawn, in all of Imura's drawings in which member 4 is depicted,¹⁴ each of the flanges of member 4 are spaced apart from seizing walls 3, 3'. Thus, the flanges of member 4 cannot prevent axial movement of member 4 relative to seizing walls 3, 3', because the flanges of member 4 do not abut seizing walls 3, 3'. The Office further alleges that "Imura clearly teaches flanges at each end of the insert (4) which is well known as a conventional means of preventing axial movement of the insert relative to the walls 3, 3' as supported by example within Tabor...which clearly teaches that it is well known that 'flanges 6 will prevent substantial movement of the sleeve 2 in the openings 26.'¹⁵ Tabor cannot be properly used to provide an example of Imura's flanges preventing movement relative to seizing walls 3, 3' because Imura's flanges cannot prevent such movement, as discussed above. Furthermore, Tabor is not cited in the present rejection but is merely used to support a reference cited in the rejection, *i.e.*, Imura. If the Office wishes to rely on the disclosure of

¹⁰ See, *inter alia*, *In re Fine*, 5 USPQ2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 USPQ2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 USPQ (BNA) 685, 687 (Fed. Cir. 1986).

¹¹ Examiner's Answer, p. 6, I. 17, through p. 7, I. 19.

¹² Final Office Action, Detailed Action, p. 6, II. 1-2.

¹³ Examiner's Answer, p. 8, II. 3-9.

¹⁴ See Imura, Figures 1, 2A, and 2B.

¹⁵ Examiner's Answer, p. 8, II. 16-18.

Tabor in the rejection, the Office should cite Tabor in the rejection, rather than merely using Tabor to support a non-existent teaching in Imura.

In the Examiner's Answer, the Office alleges that Appellant argues that Tabor "teaches away from anti-friction insert member."¹⁶ Appellant fails to understand wherein Appellant's Appeal Brief Appellant argues that Tabor teaches away from the claimed anti-friction insert member. Appellant, however, continues to assert that "Imura...teaches away from 'an anti-friction insert member.'"¹⁷ Concerning the Office's discussion of the teachings of Tabor,¹⁸ Applicant addresses the suitability of Tabor's sleeve 44, as well as the materials made therefrom, above and in his Appeal Brief.¹⁹

In the Examiner's Answer, the Office states that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper."²⁰ Appellant, however, respectfully submits that any attempt to assert that a combination of AAPA, Imura, and Tabor discloses or suggests the claimed invention as a whole is necessarily based upon an improper use of hindsight using Appellant's disclosure as a roadmap. Hindsight, however tempting, is a forbidden zone.²¹ The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time of the invention.²² As discussed above, one of ordinary skill in the art at the time of the invention would have understood that Imura relies upon the elastic nature of its member 44 to operate, based upon the teachings of Imura. What is lacking is a rational reason that would have prompted one of ordinary skill in the art to have used an anti-friction material (Tabor) in a device that clearly

¹⁶ Examiner's Answer, p. 8, ll.

¹⁷ Appeal Brief, p. 16, ll. 14-16.

¹⁸ Examiner's Answer, p. 9, l. 22, through p. 10, l. 5.

¹⁹ See p. 5, ll. 4-16, herein and Appeal Brief, p. 13, l. 23, through p. 14, l. 7.

²⁰ Examiner's Answer, p. 9, ll. 8-14.

²¹ *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 288 USPQ 90, 98 (Fed. Cir. 1985).

²² *Sensorics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

employs friction to operate (Imura). Absent such rational reasoning, the rejection could only have been constructed using impermissible hindsight.

In the Examiner's Answer, the Office contends that "the suggestion for combining [Imura and Tabor] is found within Imura and Tabor, as discussed above."²³ However, as discussed herein above and in Appellant's Appeal Brief, one of ordinary skill in the art would not have been prompted to use an anti-friction material (Tabor) in a device that clearly employs friction to operate (Imura).

²³ Examiner's Answer, p. 10, ll. 2-3.

Conclusion

In view of the foregoing reasons and the reasons stated in Appellant's Appeal Brief, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's rejections as to all of the appealed claims.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. 502806.

Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.

Respectfully submitted,

1 December 2008
Date

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